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UNITED STATES PATENT AND TRADEMARK OFFICE Technology Center 2600

Inventor(s): Amir Doron

Confirmation No.: 4168

Application No.: 09/360,419

Examiner: B.C. Genco

Filing Date: 7/23/1999

Group Art Unit: 2615

Title: Digital Still Camera with Still and Motion Image Capabilities

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on 6/3/2005. This Reply Brief is being filed pursuant to 37 CFR 41.41 within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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Respectfully submitted,

Amir Doron

By Michael H. Jester ✓

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**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:

Amir Doron

Serial No.: 09/360,419

Filed: July 23, 1999

For: *Digital Still Camera with Still and
Motion Image Capabilities*

Conf. No.: 4168

Art Unit: 2615

Examiner: Brian C. Genco

REPLY BRIEF

BOARD OF PATENT APPEALS & INTERFERENCES
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AND INTERFERENCES

Sir:

Applicant, through his undersigned attorney, hereby submits this Reply Brief pursuant to 37 CFR §41.41 in response to the EXAMINER'S ANSWER mailed June 3, 2005.

In the EXAMINER'S ANSWER, the examiner presented new grounds of rejection pursuant to 37 CFR §41.39(a)(2). More specifically, Claims 11-19 and 21-25 now stand rejected for alleged obviousness over U.S. Patent No. 5,440,343 of Parulski et al. in view of U.S. Patent No. 6,148,031 of Kato. Apparently, the previous obviousness rejection of these same claims based on Kato in view of Parulski et al. has been withdrawn. Accordingly, the examiner has effectively admitted that the subject matter of Claims 11-19 and 21-25 would not have been obvious over Kato in view of Parulski et al., as applied in the fourth Office Action mailed January 25, 2005.

Pursuant to 37 CFR §41.39(b)(2), Applicant hereby requests that his appeal be maintained. Argument traversing the new grounds of rejection is set forth hereafter in compliance with 37 CFR §41.37(c).

After six years of pendency and four Office Actions, the examiner's recent switch to Parulski et al. as the base reference does not cure the previous deficiencies in attempting to establish a *prima facie* case of obviousness using Kato as the base reference.

Parulski et al. discloses a camera capable of producing a sequence of low resolution analog NTSC motion images at a relatively high frame rate, and high resolution still images at a relatively low frame rate. The examiner admits "Parulski does not even disclose to perform [sic] JPEG or MPEG compression encoding on the images" (EXAMINER'S ANSWER, page 9). Parulski et al. is primarily concerned with the structure and operation of an image sensor that incorporates column-selective "charge clearing" structures and column-selective "charge parking" structures. This sensor architecture allows the image sensor of Parulski et al. to provide different image aspect ratios for motion and still modes.

Kato is concerned with the ability to selectively record a single high resolution still image picture during a motion video sequence. See column 2, lines 30 - 34. Kato is not concerned with generating a sequence of low resolution still image files (e.g., JPEG files) for conversion into a motion video sequence (e.g., MPEG files). There are generalized statements in Kato regarding the benefits of JPEG and MPEG compression in terms of reducing the quantity of recorded data and reducing standby time.

The examiner's most recent position is essentially that it would have been obvious to use JPEG compression on the motion picture sequence images of Parulski et al. and then to re-compress the series of resulting JPEG images with MPEG compression using firmware, apparently to reduce delay, as allegedly suggested by Kato. This position fails to satisfy the tripartite test for establishing a *prima facie* case of obviousness laid down in *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

First, the generalized statements in Kato do not provide the motivation required for modifying Parulski et al. to sequentially employ two compression techniques not even disclosed in Parulski et al. Second, because Parulski et al. uses a special image sensor to achieve different aspect ratios in motion and still modes, there would not have been a reasonable expectation of success in attempting to employ the complex inter-frame correlation and intra-frame coding

techniques of Kato which are not adapted for use with such a special image sensor. Third, even if the examiner's proposed modification were made, the result would still not be the invention of independent Claims 11 and 21 on appeal, which require that the sequence of low resolution image files be converted to a motion video sequence utilizing *firmware*. Kato utilizes hardware to execute his complex inter-frame correlation and intra-frame coding.

The rejection of Claims 19 and 24 for alleged obviousness over Parulski et al. in view of Kato in view of U.S. Patent No. 6,226,449 of Inoue et al. is traversed for the same reasons set forth above.

The rejection of Claim 25 for alleged obviousness over Parulski et al. in view of Kato in view of U.S. Patent No. 6,771,896 of Tamura et al. is traversed for the same reasons set forth above.

The latest obviousness rejections impermissibly use Applicant's own disclosure as an instruction book on how to reconstruct the prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1987).

For the foregoing reasons, the rejection of Claims 11-19 and 21-25 for alleged obviousness over Parulski et al. in view of Kato should be reversed.

No fees are believed to be due in connection with the filing of this Reply Brief. However, should any applicable fees be required, authorization is hereby given to charge such fees to Deposit Account No. 08-2025.

Respectfully submitted,

 7-28-05

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